UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/846,989	05/01/2001	Josephine E. Lometillo	88265-4031	3913

28765 7590 05/29/2003

WINSTON & STRAWN
PATENT DEPARTMENT
1400 L STREET, N.W.
WASHINGTON, DC 20005-3502

EXAMINER	
BHAT, NINA NMN	
ART UNIT	**PAPER NUMBER**
1761	6

DATE MAILED: 05/29/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/846,989	LOMETILLO ET AL.	
	Examin r	Art Unit	
	N. Bhat	1761	

-- The MAILING DATE of this communication app ars on the cover she t with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *7-16-2001 & 10-02-2002* .

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-20* is/are pending in the application.

4a) Of the above claim(s) *11-20* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-10* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☒ Claim(s) *1-20* are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *16 July 2001* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) *5* .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:

I. Claims 1-10, drawn to a water ice molded product, classified in class 426, subclass 91.

II. Claims 11-20, drawn to a process of making a frozen confectionery product, classified in class 426, subclass 249.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions II and I are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the frozen ice confection can be made by a process which is materially different than what has been claimed in the group II claims, for example the ice confections can be made by mixing the water ice ingredients, followed by pouring the water ice mixture into cooled dual compartmented molds, adding the core material into the second inner compartment of a mold freezing the molds and inserting a stick into the molds after freezing and then dip spraying a coating which contains stabilizers or coatings which can provide a transparent of the water ice composition surrounding the core or the water ice confection can be aerated while being frozen which controls the ice crystallization and thereby the transparency to provide a molded product, or simply a multi-colored core product which includes a stick can be dipped into a water ice confection to provide a shell or coating around the multi-colored core product.

3. Because these inventions are distinct for the reasons given above and the search required for Group II is not required for Group I, restriction for examination purposes as indicated is proper. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

4. During a telephone conversation with Mr. Fanucci on May 21,2003 a provisional election was made with traverse to prosecute the invention of Group I, claims 1-10. Affirmation of this election must be made by applicant in replying to this Office action. Claims 11-20 have been withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

5. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

6. Action on the merits of claims 1-10 follows:

7. Claims 4, 9 and10 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. A broad range or limitation together with a narrow range or limitation that falls within the broad range or limitation (in the same claim) is considered indefinite, since the resulting claim does not clearly set forth the metes and bounds of the patent protection desired. Note the explanation given by the Board of

Patent Appeals and Interferences in *Ex parte Wu*, 10 USPQ2d 2031, 2033 (Bd. Pat. App. & Inter. 1989), as to where broad language is followed by "such as" and then narrow language. The Board stated that this can render a claim indefinite by raising a question or doubt as to whether the feature introduced by such language is (a) merely exemplary of the remainder of the claim, and therefore not required, or (b) a required feature of the claims. Note also, for example, the decisions of *Ex parte Steigewald*, 131 USPQ 74 (Bd. App. 1961); *Ex parte Hall*, 83 USPQ 38 (Bd. App. 1948); and *Ex parte Hasche*, 86 USPQ 481 (Bd. App. 1949). In the present instance, claim 4 recites the broad recitation of a combination of sucrose and glucose, and the claim also recites "preferably 15-25% sucrose" and "preferably 2-5% of glucose" which is the narrower statement of the range/limitation. Applicant can recite both the sucrose and glucose amounts in claim 4 deleting the preferably language or could draft a dependent claim to recite the amounts of sucrose and glucose. In claim 9, applicant recites a divalent cation used in an effective amount to react with a hydrocolloid and then recites is "preferably at a level of from 0.1 to 1% by weight". Applicant should delete the preferably language from the claim. In claim 10, applicant recites a stabilizer comprising a hydrocolloid blend of pectin and guar gum, and then recites the amount of pectin and guar gum used with the "preferably" language. Again, applicant can just delete the preferably language and recite that the stabilizer comprises a hydrocolloid blend of pectin and guar gum, wherein the pectin is present in an amount from 0.1-3% by weight and wherein the guar gum is present in an amount from 0.1-1.15% by weight. Suitable correction is required.

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

9. Claim 1 is rejected under 35 U.S.C. 102(e) as being anticipated by Cox.

Cox teaches a frozen ice confection wherein the opacity or transparency is controlled and wherein the confection can have imbedded indicia, which becomes viewable as the transparency of the confection increases. Specifically, Figure 4, depicts a frozen confectionery product on a stick which is a water ice molded product having a translucent water ice shell and a core or "surprise" which is visible or becomes visible during consumption.[Note the abstract, Figure 4 and claim 1 of Cox]

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

10. The factual inquiries set forth in *Graham* **v.** *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.

2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

11. Claims 2-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cox in view of Best et al.[USP 6,379,724].

Cox teaches the invention substantially as claimed.

Cox teaches a controlled transparency combination frozen ice confection product which includes a interior core and a second water ice shell which enrobes the interior core, the interior core becoming visible while sucking or wherein the temperature increases which reveals the interior core which can be a candy or confection. The composition of the water ice shell contains 53% fructose, 4 % gelatin, 0.2% citric acid, 0.3 orange color/flavor and 42.5% water. The composition was mixed and poured into a mold, which was cooled by brine at -15°C . A candy was placed within the mix and a stick was inserted. A transparent structuring agent is added to the water ice composition and includes materials, which thicken the ice-free liquid forming a gel. the gelling agents include gelatin, iota-carrageenan, kappa-carrageenan, pectins, alginates and locust bean gum. Cox teaches that some of the gelling agents are thermally setting such as gelatin or locust bean gum, other agents require specific ions such as calcium to gel iota carrageenan or low methoxy pectins.[Note Column 2, lines 2-49]. Cox further teaches that one having skill in the art can determine a suitable structuring agent and incorporation level through consideration of the required texture, setting process and any addition required (e.g. the type and level of ions, pH, sugar concentration, strength

of the gel required) and the selection and criteria for selection is well documented and well known to the ordinary artisan.

Best et al.[6,379,724] teach a slow melting coating for ice confections. The coating includes a gelled pectin which is a reaction product of a n aqueous based sol of pectin with a setting agent such as a calcium salt which causes gelation of the sol to which a confectionery core which can includes an ice cream, ice cream analogue, frozen yogurt, sherbet, sorbet, ice milk, frozen custard or water ice can be coated with the gel to enrobe the core. Best teaches that the ice coating includes the sol, the calcium ions, sugar, water , acids, colorants and flavorings. [Note Column 9, lines 25-63]

It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide a water ice molded product which comprises a translucent water ice shell, a multi-colored core provided within the shell which core is visible in the product before and during consumption and stick for holding the product from reading Cox in view of Best et al. because as stated above, Cox anticipates applicant's broad claims which provides and ice confection with controlled transparency wherein a "surprise" or core or candy is enrobed with a water ice confection which includes transparent gelling or structuring agents which permits the control of transparency of the shell material which can make the core material become visible or the opacity of the shell is controlled to provide a translucent shell. Cox teaches that structuring agents include gelling agents and teaches how to select the gelling agent to thicken the ice free liquid is well known and well documented. Cox teaches that when

using pectin a calcium ion or cation is required in order to cause gelation. Cox further teaches that some mixtures of structuring agents can be used and further teaches that not all gels are transparent. The transparency of a gel for use can be determined by visual observation and that the ordinary artisan can determine the type of structuring agent and incorporation levels by considering and evaluating of the required texture, setting process (thermal or ionic) and any additional requirements in the preparation of the water ice, for example, the type and level of ions, pH, sugar concentration, strength of the gel etc. Best et al. teaches providing a water ice coating which specifically uses a pectin and calcium salt in amounts which are used by applicant and further that the water ice coating which includes the pectin sol and calcium salt fully enrobes or provides a shell around a frozen confectionery core. The combined teachings of Cox and Best et al. renders applicant's invention as a whole obvious to one having ordinary skill in the art at the time the invention was made.

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Sharkasi et al. teaches a frozen desert which changes color as it is consumed. Vaghela et al. teach a process for preparing a molded aerated frozen bar. Daniel et al. teach a method of adding an antifreeze protein to an ice confection to restrict the flow of flavor and color. Dea et al. preparing a frozen ice confection comprising aerated compositions of ice crystals. Best et al.[6,399,134] teach an aqueous based frozen confection having a specific hardness and includes a stabilizer composition comprising a mixture of guar, locust bean gum and carboxymethylcellulose and carrageenan. Hotalin teaches a process for creating textured and transparent ice

products. WO 93/21776 teach and ice lolly which is partially transparent an in a non-crystalline state and the method of making the ice lolly.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to N. Bhat whose telephone number is 703-308-3879. The examiner can normally be reached on Monday-Friday, 9:30AM-6:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Milton Cano can be reached on 703-308-3959. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-306-5665.

N. Bhat
Primary Examiner
Art Unit 1761

May 27, 2003